

REMARKS

The Official Action of 12 October 2005 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claims 1, 3, 4-6, 8-9 and 13-14 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Valerius in view of JP 58209508 and Applicants' statement of the prior art at page 1, lines 15-24 of the specification. Claims 7 and 10-11 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Valerius in view of JP '508 and further in view of SU 865873. Applicants respectfully traverse these rejections.

The laminate as defined in the claims of record comprises:

- (i) a core of kraft paper (13);
- (ii) at least one layer of natural wood (14) (the decorative layer of the laminate); and
- (iii) at least one covering layer (15) which includes a coating film (17) and a substrate film (16).

The claimed laminate differs from the laminate described in the primary reference, Valerius, in that: (a) it has a natural wood layer instead of an alpha-cellulose paper layer (with printed design) as "decorative layer" (the layer that provides the laminate's external aesthetic appearance); and (b) it has a covering layer formed by two films (the substrate film (16) and the coating film (17) instead of a thermoplastic film). Nevertheless, the Examiner contends that it would have been obvious from the secondary references and from Applicants' statement of the prior art to modify Valerius to arrive at the claimed invention. Applicants respectfully disagree.

First, Applicants respectfully note that there would have been no motivation, absent the hindsight provided by the present specification, to modify the Valerius laminate by the inclusion of a wood layer. The motivation purportedly found by the Examiner in the specification ("Applicant's statement. . .teaches that it is known to incorporate a wood layer between the kraft paper core and the surface covering layers in order to form a strong board") is respectfully submitted to be a misreading of the specification. The statement to which the Examiner refers ("the said materials being impregnated by synthetic resins which help to create a very compact and strong board") does not mean, nor would it be construed by one of skill in the art to mean, that the wood layer is desirable for board strength. To the contrary, the specification makes clear that the wood layers do not contribute at all to form a strong board. See specification at page 1, line 18 ("very thin sheet of natural wood"), and page 5, line 2 ("thin sheets of wood 4, 4").

Moreover, it respectfully does not make sense for one of skill in the art to include

another decorative layer into a laminate that already has a decorative layer; this would mean including two "decorative" layers in one laminate, one of which would not be visible from above. In this connection, Valerius requires that the decorative layer described therein be superimposed above the kraft paper core sheets with only clear or unpigmented layers superimposed above the decorative layer (Valerius at column 1, lines 22-50). Accordingly, there could have been no motivation to superimpose a wood layer above Valerius' decorative layer. However, if the wood layer were not superimposed above Valerius' decorative layer, the combination would not arrive at the claimed invention which requires the substrate layer atop the natural wood layer to promote adhesion between the coating film and the natural wood layer.

Furthermore, there would not have been a motivation, absent the hindsight provided by the present specification, to include in Valerius' laminates the recited substrate comprising a paper which is impregnated with a compound formed by 80-95 wt% phenolic resin and 20-5 wt% adhesion-promoting polymer. The Examiner relies upon JP '508 for the motivation to modify the Valerius laminates in this manner, but Applicants respectfully submit that this reliance is misplaced. JP '508 teaches the use of the melamine resin for reinforcing a wood panel, a completely different function with respect to the use of the melamine resin than in Valerius. Given the function described in JP '508, even assuming for the sake of argument that JP '508 were properly combinable with a Valerius laminate that were modified to include a wood layer, the combination would not arrive at the claimed laminate. Rather, the combination would arrive at a laminate wherein the surface of the wood veneer were reinforced with the melamine resin.

There would have been no motivation, absent the hindsight provided by the present specification, to include the JP '805 resin into a substrate layer comprising a paper (rather than a wood) core.

In this latter connection, although the Examiner compares the melamine formaldehyde resin impregnating the alpha-cellulose paper layer of Valerius with the substrate layer which is used in the claimed invention, Applicants respectfully submit that the uses of the respective layers are not comparable. In the claimed invention, the melamine resin is used as part of the compound that impregnates the substrate film (16) as an "adhesion promoter" between the coating film (17) and the wood layer (14). There is no comparable usage in Valerius.

With particular respect to the rejection of claims 7 and 10-11, these claims are additionally patentably distinguishable over the cited art in that there is no motivation in SU '873 to use a PDVF layer in the claimed coating film. In particular, there is nothing in the reference to show or suggest the adhesiveness of such layer to a laminate with a layer of wood, which would be required to motivate one of skill in the art to use a PDVF coating layer in the claimed laminate.

In view of the above, it is respectfully submitted that the cited references cannot set forth even a *prima facie* case of obviousness for the invention as claimed because (a) there is no motivation in the prior art for their combination, and (b) the combination, even if proper, would not arrive at the claimed invention (see MPEP Section 706.02(j)). Accordingly, it is

respectfully submitted that the rejections of record should be withdrawn and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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